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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PETER K. KASSAB

Appeal 2007-2684
Application 09/901,472
Technology Center 1700

Decided: February 4, 2008

Before BRADLEY R. GARRIS, THOMAS A. WALTZ, and CATHERINE
Q. TIMM, *Administrative Patent Judges*.

TIMM, *Administrative Patent Judge*.

DECISION ON APPEAL

1 Appellant appeals under 35 U.S.C. § 134(a) from the Examiner's
decision rejecting claims 1, 2, 4-6, 11, 13, 14, and 22-24. We have
jurisdiction under 35 U.S.C. § 6(b).

We AFFIRM-IN-PART.

I. BACKGROUND

The invention relates to sticker assemblies, an intermediary for a window sticker, and methods of releasably adhering a sticker to a vehicle windshield. Claim 1 is illustrative of the subject matter on appeal:

1. A sticker assembly comprising:

a sticker having an indicia-bearing surface, the sticker having peripheral edges;

a non-perforated layer of vinyl film having a first side and a second side, the second side having a low-tack adhesive layer, the vinyl film having outer edges; and

an adhesive disposed between the sticker and the first side of the film resulting in direct contact of the adhesive with the vinyl film and fixedly attaching the sticker to the vinyl film and wherein the indicia-bearing surface is viewable through a receiving surface, and wherein the vinyl film is trimmed to define peripheral edges of the vinyl film thereby placing the peripheral edges of the vinyl film essentially in registry with peripheral edges of the sticker, and wherein the second side of the vinyl film is adapted to releasably adhered to a receiving surface.

Appellant requests review of all the rejections maintained by the Examiner, namely:

1. The rejection of claims 1, 14, and 22 under 35 U.S.C. § 103(a) as unpatentable over Langen (US 5,290,067 issued Mar. 1, 1994) in view of Honaker et al. (US 4,935,288 issued Jun. 19, 1990) or Yoshida et al. (US 4,670,490 issued Jun. 2, 1987);
2. The rejection of claims 1, 2, 4-6, 11, 13, 14, and 22-24 under 35 U.S.C. § 103(a) over Mehrle (DE 29 720 696 published Aug. 6, 1998) in view of Courtney (US 5,622,389 issued Apr. 22, 1997) and Nishizawa (JP H09-97014 published Apr. 8,

1997) and optionally further in view of at least one of the admitted prior art (APA) (Specification pp. 1-3 and p. 18, ll. 12-17), Hawkins (GB 2 174 233A published Oct. 29, 1986) and Langen (US 5,290,067 issued Mar. 1, 1994);

3. The rejection of claim 23 under 35 U.S.C. § 112, ¶ 2 as indefinite; and
4. The rejection of claim 23 under 35 U.S.C. § 103(a) over Mehrle (DE 29 720 696 published Aug. 6, 1998) in view of Nishizawa (JP H09-97014 published Apr. 8, 1997) and further in view of Hawkins (GB 2 174 233A published Oct. 29, 1986) and Langen (US 5,290,067 issued Mar. 1, 1994).

II. DISCUSSION

A. The Obviousness Rejection of Claims 1, 14, and 22 over Langen in view of Honaker or Yoshida

Turning first to the rejection of claims 1, 14, and 22 under 35 U.S.C. § 103(a) over Langen in view of Honaker or Yoshida, we note that Appellant presents a general argument as well as arguments focusing on claims 1 and 14. We address each in turn.

1. Suggestion or Motivation to Combine

Appellant presents one overarching argument applicable to all the rejected claims: According to Appellant, the Examiner erred by failing to cite a specific disclosure in any of the references supporting the finding of a reason to combine (Br. 32). The Examiner, on the other hand, finds that the reason to combine flows from the teachings of the references, specifically, Langen suggests using label stock for the tape 34, and the secondary

references to Honaker and Yoshida teach using vinyl film in label stock materials: This provides a suggestion to use vinyl film for tape 34 (Ans. 5-6 and 19-20). The issue that arises is: Has Appellant overcome the rejection by showing that the evidence does not support the Examiner's finding of a reason to combine?

We answer this question in the negative.

“Section 103 forbids issuance of a patent when ‘the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.’” *KSR Int'l Co. v. Teleflex Inc.*, 127 S. Ct. 1727, 1734 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations. *Graham v. John Deere Co.*, 383 U.S. 1, 17-18 (1966). *See also KSR*, 127 S. Ct. at 1734 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”).

Recently, in *KSR Int'l Co. v. Teleflex Inc.*, the Supreme Court set aside any “rigid” application of the teaching, suggestion, motivation (“TSM”) test, advising that: “A person of ordinary skill is also a person of ordinary creativity, not an automaton.” 127 S. Ct. at 1742. The Supreme Court clarified that while “it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does. . . . the analysis need

not seek out precise teachings [in the prior art] directed to the specific subject matter of the challenged claim.” *Id.* at 1741. Therefore, we cannot agree with Appellant that the mere fact that none of the references relied upon by the Examiner expressly states a reason for using vinyl films in the tape 34 of Langen means that there is no support for the Examiner’s finding of a reason to combine. We agree with the Examiner that a reason to combine arises from the teachings of the references. Langen suggests using label stock for the tape 34. One of ordinary skill in the art would, therefore, select a known label stock material. The Examiner has provided evidence that vinyl films were known label stock materials. The reason to combine flows logically from the teachings of the references.

We note that “vinyl film,” as that terminology is used in the claim, includes a great variety of film compositions as evidenced by the Specification. As stated in the Specification:

It is understood that the vinyl film 100 can include wide range of different types of films. The vinyl film 100 can include any film that has flexibility to accommodate simple or compound curves such as in a car window, and also have sufficient stiffness and rigidity to resist premature peeling or curling from a receiving surface. The vinyl film 100 can include, for example, polyester films, polypropylene films, polyethylene films, polystyrene films and the like.

(Specification 26:5-10). Given that Mehrle desires a transparent film intended to be applied to a car window, the selection of the film composition would have entailed selecting a known transparent polymer having the necessary flexibility. 1 “[A] prior art reference must be ‘considered together with the knowledge of one of ordinary

skill in the pertinent art.’” *In re Paulsen*, 30 F.3d 1475, 1480 (Fed. Cir. 1994).

Appellant has failed to convince us of a reversible error with respect to the Examiner’s finding of a reason to combine the repositionable window label of Langen having a tape 34 that is described as a label stock material with known vinyl-based label stock materials.

2. Claim 1

Turning to the arguments directed to specific claims, with respect to claim 1, Appellant contends that Langen does not teach or suggest that “the vinyl film is trimmed to define peripheral edges of the vinyl film thereby placing peripheral edges of the vinyl film essentially in registry with peripheral edges of the sticker” as required by the claim.

As a first matter, we note that claim 1 is directed to a sticker assembly, i.e., a product. As such, it is the patentability of the product defined by the claim, rather than the process for making it that we must gauge in light of the prior art. *In re Wertheim*, 541 F.2d 257, 271 (CCPA 1976); *In re Brown*, 459 F.2d 531, 535 (CCPA 1972). It has long been held that “[i]f the product in a product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” *SmithKline Beecham Corp. v. Apotex Corp.*, 439 F.3d 1312, 1317 (Fed. Cir. 2006) (quoting *In re Thorpe*, 777 F.2d 695, [697] (Fed. Cir. 1985)).

According to Appellant, the structure of claim 1 is distinguishable from that of Langen because the film of the claimed invention has a trimmed edge and the structure of Langen does not (Br. 33). The Examiner finds, however, that Langen’s product has the same structure as that claimed

because the edge of Langen's label stock tape 34 is in registry with the longitudinal edge 15 of web 12 as shown in Figures 2 and 3, the edge of the label stock tape also being in registry with the transverse edge formed by bursting the perforations 18. The issue arising is: Is it reasonable to conclude from the disclosure of Langen that the structure arising from the process of making the repositional sticker has the same or substantially the same structure as claimed notwithstanding the fact that the process of making the sticker assembly is different?

We answer the above question in the affirmative.

Langen illustrates tape 34 along the top and bottom edges (edges 15 and 16, respectively) of the sticker 10 in Figure 2. The tape edges are shown in registry with the top edge 15 of web 12 (Fig. 3 illustrating top edge 15 as shown in Fig. 2). Langen also discloses that after the tape is applied adjacent edges 15 and 16 (Langen, col. 3, ll. 53-60) the web 12 is slit and burst to remove the marginal portions of the web 12 along the edges 15 and 16 and burst along perforations 18 (Langen, col. 4, ll. 19-25). We find that the end product structure is the same or substantially the same as claimed: The edges of the tape 34 of Langen end up in registry with the peripheral edges of the web 12.

Because it is reasonable to conclude the structure of Langen's edges is the same or substantially the same as that claimed, the burden was shifted to Appellant to show that there is, in fact, a structural difference between the claimed "trimmed" edge and the edge of Langen. *See In re Best*, 562 F.2d 1252, 1255 (CCPA 1977) ("Where, as here, the claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes, the PTO can require an applicant to

prove that the prior art products do not necessarily or inherently possess the characteristics of his [or her] claimed product.) Appellant has not provided any objective proof showing a patentable difference.

3. *Claim 14*

Turning to claim 14, we determine that the issue presented is similar to that of claim 1: Does Langen teach or suggest a sticker assembly structure with edges in registry as claimed?

We answer this question in the affirmative.

The structure of Langen includes a release liner 37 (claimed protective layer) over a two-sided tape 34 with low tack adhesive 36 on one side and adhesive 35 on the other side overlying a web 12 serving as the indicia-bearing windshield sticker (Langen, Figs. 2-3; col. 4, ll. 47-57). The outer edges of the tape 34 and release layer are in registry with edges 15 and 16 of the web 12 (Langen, Fig. 3; col. 3, ll. 53-60, col. 4, ll. 19-25). Again, it is reasonable to conclude that the structure is the same or substantially the same whether or not the structure arises from trimming as claimed. The burden again shifted to Appellant to show a patentable difference in structure. *Best*, 562 F.2d at 1255. There is no evidence of such a difference.

We determine that Appellant has not established a reversible error in the Examiner's rejection of claim 14.

4. *Claim 22*

Appellant presents no further arguments directed to limitations in claim 22 not already addressed above. Therefore, the rejection of claim 22 is sustained for the reasons already discussed.

5. *Conclusion*

We sustain the rejection of claims 1, 14, and 22 under 35 U.S.C. § 103(a) as unpatentable over Langen in view of Honaker or Yoshida.

B. The rejection of claims 1, 2, 4-6, 11, 13, 14, and 22-24 over Mehrle (DE 696) in view of Courtney and Nishizawa (JP 014) and optionally further in view of at least one of the admitted prior art (APA), Hawkins (GB 233) and Langen

With respect to the rejection of claims 1, 2, 4-6, 11, 13, 14, and 22-24 over Mehrle (DE 696) in view of Courtney and Nishizawa (JP 014) and optionally further in view of at least one of the admitted prior art (APA), Hawkins (GB 233) and Langen, Appellant presents a general argument as well as arguments directed to specific claims. Where sufficiently separate arguments are presented for separate claims to allow separate review, we address the claims separately. We find such separate arguments for claims 1, 6, and 13. We will address each issue in turn.

1. *Suggestion or Motivation to Combine*

Initially, we address the issue arising from Appellant's general argument: Has Appellant shown a reversible error on the basis that there is no reason to combine the teachings of the references or because Mehrle teaches away from the combination?

We answer this question in the negative.

The German reference to Mehrle describes a problem with car window stickers (they are hard to remove from the window) and suggests a solution involving applying the window sticker to a transparent film having low tack adhesive on one side and then sticking the low tack adhesive side of this assembly to the window. The result is a sticker assembly that can be

easily detached from the window (Mehrle translation, p. 3). The detachment aid (film with low tack adhesive) is of a format selected so that “the majority and most common stickers can be stuck to it.” (Mehrle translation, p. 3, ll. 13-14). This suggests that the detachment aid will be, in many cases, larger than the sticker. That Mehrle suggests using a film larger than the sticker is not disputed by Appellant (Br. 21).

Courtney addresses a similar problem (bumper stickers are hard to remove from car bumpers) with a similar solution (an easily detachable assembly including a transparent film upon which the bumper sticker is mounted) (Courtney, col. 1, ll. 11-20; col. 52-59). Courtney, however, recognizes a further problem: There is a risk of theft of stickers that are easily removed. Courtney discloses solving this problem by, after attachment of the sticker, trimming the mounting sheet so it becomes “virtually undetectable to the casual observer” (Courtney, col. 2, ll. 18-21 and ll. 50-52).

The above facts support the Examiner’s conclusion that it would have been obvious to one of ordinary skill in the art to trim the detachment aid of Mehrle for the reason expressed by Courtney, i.e., to make the detachment aid undetectable to the casual observer and prevent theft of the sticker. “[A]ny need or problem known in the field of endeavor at the time of invention and addressed by the patent can provide a reason for combining the elements in the manner claimed.” *KSR*, 127 S. Ct. at 1742.

Nor can we agree with Appellant that Mehrle teaches away from trimming. Mehrle is simply silent about trimming, the reference neither discourages trimming nor leads one of ordinary skill in the art away from trimming. When the prior art teaches away from a combination, that

combination is more likely to be nonobvious, *KSR*, 127 S. Ct. at 1739–40, but to teach away, a reference must discourage one of ordinary skill in the art from following the path set out in the reference, or lead that person in a direction divergent from the path that was taken by the applicant, *In re Gurley*, 27 F.3d 551, 553 (Fed. Cir. 1994), or teach away from a use that would render the result inoperable. *McGinley v. Franklin Sports, Inc.*, 262 F.3d 1339, 1354 (Fed. Cir. 2001). Mehrle’s silence is not a teaching away.

2. Claim 1

Turning to claim 1, Appellant again raises the issue of whether there is a sufficient reason to combine the teachings of Mehrle and Courtney. As we determined above, there is sufficient evidence of a reason to combine the teachings of those references.

Appellant also contends that “[t]here is no disclosure or suggestion within the four corners of the Japan ‘014 reference [Nishizawa] that would give one the motivation to combine it with German ‘696 [Mehrle] and Courtney.” (Br. 23). The issue arising is: Has Appellant shown that the Examiner reversibly erred in finding that there was a reason for using vinyl film in the detachment aid of Mehrle?

We answer that question in the negative.

Mehrle is silent with respect to the material used for the “transparent foil” of the detachment aid. Therefore, one of ordinary skill in the art would have selected transparent films known in the art. Nishizawa teaches a transparent vinyl chloride sheet used in a sticker assembly.

The evidence supports the Examiner’s finding of a reason to combine.

In order to prove non-obviousness, Appellant relies upon evidence in the form of the Kassab Declaration (Br. 21-22). So the further question arises: Does the Kassab Declaration provide sufficiently probative evidence of non-obviousness such that the totality of the evidence, when considered anew, weighs in favor of a conclusion of non-obviousness?

We answer this question in the negative.

As a first matter, Kassab's opinion on the ultimate conclusion of obviousness (Kassab Declaration ¶ 7) is not evidence and we place no weight on that ultimate opinion. *See In re Lindell*, 385 F.2d 453, 456 (1967) ("Appellant's opinion on the ultimate legal issue is not evidence in the case.").

However, what Kassab felt was obvious to him is entitled to some weight. *See Lindell*, 385 F.2d at 456 ("we do feel that some weight ought to be given to a persuasively supported statement of one skilled in the art on what was not obvious to him."). The Declaration is offered to support Appellant's contention that trimming was not readily obvious to him and was not known in the art (Br. 21-22). In evaluating the probative value of Mr. Kassab's opinion on this matter, we must consider the nature of the matter sought to be established as well as the strength of the opposing evidence. *In re Oelrich*, 579 F.2d 86, 91 (CCPA 1978).

On the one hand, according to the Declaration, trimming was not immediately apparent to Kassab, the inventor, the benefits not being recognized until after he experimented and tested different types of films and receiving surfaces (Kassab Decl. ¶ 5). Moreover, Kassab witnessed consumers use the vinyl film without trimming; had to explain the trimming step and its benefits to customers and commercial entities; and despite

specific product instructions explaining the trimming steps and its benefits, a commercial catalog company created, published, and distributed a national layout showing the use of the product without trimming (Kassab Decl. ¶ 8).

On the other hand, Courtney specifically describes trimming a mounting film around a bumper sticker to make the mounting film undetectable to the casual observer and to prevent theft of the removable sticker.

The Kassab Declaration provides no details, nor are there any opinions from the consumers and commercial entities themselves, explaining why those users did not trim the vinyl film. Perhaps consumers did not feel a need to perform this extra step; perhaps, they did not read the instructions; the point is that the reason is a matter of speculation. The fact that others did not always perform the trimming step, does not necessarily mean trimming was not considered, nor does it necessarily mean trimming was not obvious to those with ordinary skill in this art.

Moreover, the fact that Kassab did not recognize the benefits of trimming immediately does not show that the addition of a trimming step required capabilities beyond those of ordinary skill. *See KSR*, 127 S. Ct. at 1740 (stating that “if a technique has been used to improve one device, and a person of ordinary skill in the art would recognize that it would improve similar devices in the same way, using the technique is obvious unless its actual application is beyond his or her skill”).

Courtney, however, expressly teaches trimming a mounting sheet around a sticker.

Weighing all the evidence, we determine that a preponderance of the evidence supports the conclusion that it would have been obvious to one of

ordinary skill to trim the mounting film of Mehrle when one wished to make it undetectable to the casual observer and reduce the risk of theft as suggested by Courtney.

3. *Claim 6*

Appellant contends that claim 6 requires a protective layer that is trimmed with the vinyl film so the protective layer and vinyl film edges are in registry with the edges of the window sticker, and that none of the cited prior art disclose a protective layer for a film that is trimmed with the film (Br. 27). The Examiner contends that Hawkins and Langen provide the suggestion to cover low tack adhesive with a protective layer and Courtney suggests trimming the mounting aid. The issue arising is: Has Appellant shown that the evidence does not support the finding of a suggestion to cover the mounting film of Mehrle with a protective layer and trim the mounting film so its edges are in registry with the mounted sticker?

We answer that question in the negative.

We determine that the evidence cited by the Examiner supports the Examiner's position. Mehrle describes a detachment aid for window stickers which includes a foil with a low tack adhesive on one side. Hawkins describes placing a protective layer (backing strip 17) on the adhesive face of a sticker assembly. Hawkins discloses cutting out areas of the sticker assembly before removing the protective layer (Hawkins, p. 2, ll. 92-102). Courtney discloses trimming a mounting aid for a bumper sticker. The evidence supports the Examiner's finding of a reason to apply a protective layer to protect the adhesive both before trimming as suggested by Courtney and before applying the sticker assembly to the window.

4. *Claim 13*

Turning to claim 13, we note that this claim is directed to a method. This method involves steps of covering strips of adhesive on a windshield sticker with strips of vinyl film with intervening steps of trimming.

According to the Examiner:

it would have been an obvious alternative to use a pair of transparent film strips to cover a pair of adhesive strips instead of using one transparent film to cover a complete adhesive coating the entire surface of the sticker in view of (1) the above noted suggestion in German '696 to use transparent film having low tack adhesive as a mounting / detachment aid for known stickers, (2) the admitted prior art's teaching that known stickers include temporary city stickers made from paper having a thin line of adhesive along the side of the sticker rather than a complete adhesive layer across the entire face of the sticker so that the adhesive is not provided over the indicia bearing portion (page 18 lines 12-17) and (3) Langen's suggestion to removably secure a sticker to window using spaced strips having repositionable adhesive wherein the indicia is not covered by the repositionable adhesive (figures 2 and 3). The limitation of trimming the strips / the trimmed strips would have been obvious in view of (a) the above noted suggestion from the applied prior art to use a pair of film strips (pair of mounting / detachment aids) instead of one film strip (one mounting / detachment aid) and (2) the above noted teaching to Courtney to trim the mounting sheet material to match the shape and size of the sticker so that the mounting sheet is virtually undetectable to the casual viewer and potential for theft is reduced by the appearance of permanent affixation (col. 1 lines 61-62, col. 2 lines 24-28, 3-31, 33-46, 50-55).

(Ans. 13-14).

What is missing is a suggestion of performing the method as claimed, i.e., to provide strips of vinyl film, trim the strips, and place those strips over strips of adhesive on a windshield sticker as claimed.

We determine that the Examiner has not established a prima facie case of obviousness with respect to claim 13.

5. Conclusion

We sustain the rejection of claims 1, 2, 4-6, 11, 14, and 22-24 over Mehrle in view of Courtney and Nishizawa and optionally in view of the admitted prior art, Hawkins, and Langen. We do not sustain the rejection of claim 13 on those grounds.

C. The rejection of claim 23 under 35 U.S.C. § 112, ¶ 2 as indefinite

According to the Examiner, claim 23 is indefinite because “it is unclear if an intermediary or a sticker assembly is being claimed.” (Ans. 4). This is because, according to the Examiner, the preamble recites that the claim is directed to an intermediary, but the language in the body of the claim “are trimmed” (referring to trimming the vinyl film and protective layer so that their edges are in registry with the sticker) suggests that the sticker is being claimed. Appellant contends that claim 23 is directed to an intermediary; that claim 23 specifies that the elements positively claimed, e.g., the vinyl film and the protective layer, are trimmed; and that the sticker is not being positively claimed (Br. 13-14).

The question arising is: Would one of ordinary skill in the art understand which of the physical structures recited within the claim is being claimed?

The purpose of the definiteness requirement is:

[T]o provide those who would endeavor, in future enterprise, to approach the area circumscribed by the claims of a patent, with the adequate notice demanded by due process of law, so that they may more readily and accurately determine the boundaries of protection involved and evaluate the possibility of infringement and dominance.

In re Hammack, 427 F.2d 1378, 1382 (CCPA 1970).

“The test for definiteness is whether one skilled in the art would understand the bounds of the claim when read in light of the specification. If the claims read in light of the specification reasonably apprise those skilled in the art of the scope of the invention, § 112 demands no more.” *Miles Lab., Inc. v. Shandon, Inc.*, 997 F.2d 870, 875 (Fed. Cir. 1993) (citation omitted); *see also In re Moore*, 439 F.2d 1232, 1235 (CCPA 1971) (the indefiniteness inquiry asks whether the claims “circumscribe a particular area with a reasonable degree of precision and particularity. It is here where the definiteness of the language employed must be analyzed not in a vacuum, but always in light of the teachings of the prior art and of the particular application disclosure as it would be interpreted by one possessing the ordinary level of skill in the pertinent art.”).

The preamble states that the claim is directed to “[a]n intermediary,” so the first question is what structure constitutes an intermediary as claimed?

The Specification describes the “intermediary” as “a vinyl film having a low-tack adhesive layer used as an intermediate layer between a car windshield and a car windshield sticker.” (Specification 1:14-17). But the detailed description of the claimed embodiment, i.e., the embodiment describing the use of vinyl film with low-tack adhesive, does not use the

word “intermediary” (Specification 22:3 to 26:20). That word is used to describe the related embodiment including a layer of static cling film 20 and we determine that one of ordinary skill in the art would interpret “intermediary” as used in claim 23 in a manner analogous to its description in the static cling embodiment. In that embodiment, static cling film 20 is shown in Figure 3 as existing before the sticker is adhered and the film trimmed. The Specification also discusses the intermediary as a product existing before adherence of the sticker (Specification 15:21-23, 19:3-13, 19:27 to 20:1). However, the word “intermediary” is also depicted and discussed as the trimmed layer of film within the sticker assembly (Fig. 7; Fig. 14; Specification 21:8-9).

We determine that the meaning of “intermediary” is unclear from the Specification.

Turning to claim 23, the language of the claim does not illuminate the situation: The claim is worded in a way that does not concretely refer to an article of manufacture that exists in one point in time; rather the claim refers to articles existing in multiple points in time. First, the claim refers to the vinyl film, adhesive, and protective layer combination before trimming (“continuous, uninterrupted layer of optically clear vinyl film . . .”), then states that the vinyl film and protective layer “are trimmed,” and then recites what exists “upon removal of the trimmed protective layer.” This does not lend clarity to the claim. There can be no dispute that what is claimed is a “manufacture” and as that terminology is used in the patent statute, it refers to a tangible article or commodity; some structure that exists in one point in time. *In re Nuijten*, 500 F.3d 1346, 1356 (Fed. Cir. 2007). Just which of the

articles arising from the manipulations recited in the claim is the one concrete object of the claim is unclear.

Appellant insists that the claim is directed to the trimmed vinyl film and protective layer combination, and that the sticker is not being claimed, but in its recitation of an initial structure and acts to be performed on that structure, it becomes unclear which of the structures that occur in different points in time is the true object of the claim, and just what the claimed structure is to include. The claim fails to comply with 35 U.S.C. § 112, ¶ 2 in failing to distinctly claim what Appellant in the Brief insists is the actual invention. *See In re Collier*, 397 F.2d 1003, 1005 (CCPA 1968) (claim did not distinctly claim what Collier insisted was the invention because its recitations of intended uses, capabilities, and structure which will result upon the performance of future acts were not positive structural limitations positively defining the structural relationships between the claim elements).

D. The rejection of claim 23 over Mehrle (DE 696) in view of Nishizawa (JP 014) and further in view of Hawkins (GB 233) and Langen.

In rejecting claim 23, the Examiner has interpreted this claim as not including the window sticker, and interpreted “are trimmed” as a process limitation relating to intended use (Answer 16).

Appellant contends that claim 23 requires a vinyl film and protective layer that must be trimmed (Br. 35).

As the Examiner and Appellant have interpreted claim 23 as not limited to a window sticker, to facilitate review of this claim, we adopt that interpretation.

The remaining question thus arises: How do the words “are trimmed” in the context of the claim as a whole limit the structure of the claimed “intermediary,” and is the claimed structure unobviously different from that suggested by the references?

We again reiterate that the claim is directed to an article of manufacture, i.e., a product. “[I]t is the patentability of the *product* claimed and *not* of the recited process steps which must be established.” *In re Brown*, 459 F.2d 531, 535 (CCPA 1972). Therefore, we analyze “are trimmed” from the standpoint of how this language limits the structure of the intermediary product.

In the context of the product claim, the words “are trimmed” do not limit the size of the vinyl film and protective layer that make up the intermediary. Nor does the clause “wherein the vinyl film and protective layer are trimmed such that peripheral edges of the vinyl film and protective layer are adapted to be essentially in registry with peripheral edges of the window sticker” have any structural meaning in the absence of the sticker. There is nothing for the film and protective layer to be in registry with if the sticker is not present. At best, the limitation “are trimmed” requires the edges of the vinyl film and protective layer to be in registry with each other as such would result from the act of trimming. The claim does not require a *step* of trimming, it is only limited to a *structure* that would arise because of trimming.

Hawkins and Langen both suggest placing a protective layer in registry over low-tack adhesive on a film layer, and so placing a protective layer on the detachment aid of Mehrle flows from the teachings of the prior art. The references fairly suggest the structure of a film, adhesive, and

protective layer combination with its edges in registry as required by claim 23.

Appellant further contends that the Examiner has not pointed out a specific disclosure in the references themselves that would give one motivation to combine (Br. 35).

The Examiner finds that Mehrle describes the claimed transparent film with low-tack adhesive; Nishizawa teaches vinyl films were known transparent films; Hawkins and Langen describe covering low-tack adhesive with a protective layer, the edges being in registry with the underlying film. The Examiner concludes from the evidence that it would have been obvious to use the known transparent vinyl film and known protective layer on the detachment aid of Mehrle for their known functions.

The issue on appeal arising from the contentions of Appellant and the Examiner is: Has Appellant shown that the Examiner reversibly erred in finding that there was a reason to combine?

“The combination of familiar elements according to known methods is likely to be obvious when it does no more than yield predictable results.” *KSR*, 127 S. Ct. at 1739 (2007). Here, the predictable result of the combination is that the resulting film will be transparent as desired by Mehrle and will have its low-tack adhesive layer protected. In determining that there was an apparent reason to combine, the Examiner correctly took into account the interrelated teachings of the prior art references, the demands on those in the adhesive film and detachment aid arts, and the background knowledge of the ordinary artisan as evidenced by the references. *See KSR*, 127 S.Ct. at 1740-41 (2007) (“Often, it will be necessary for a court to look to interrelated teachings of multiple patents; the

effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue.”).

Appellant has not convinced us of a reversible error in the rejection of claim 23.

E. Evidence of Commercial Success

Appellant provides evidence that the invention “has been well-received in the marketplace” and relies upon paragraph 10 of the Kassab Declaration as evidence.¹

Paragraph 10 reads as follows:

10. My product has been well-received in the marketplace with sales both nationally and internationally. The favorable acceptance of the invention is further indicated by the fact that sales of my product have continued to increase dramatically year after year. For example, in 2004 to date, over 100,000 units of the product have been sold. This level of sales represents a very successful and wide consumer acceptance of the product, which is believed to be the result of the superiority of the product and its associated methods.

(Kassab Decl. ¶ 10).

In weighing secondary considerations along with the other evidence, the secondary considerations must be carefully appraised as to evidentiary value. *EWP Corp. v. Reliance Universal, Inc.*, 755 F.2d 898, 908 (Fed. Cir. 1985). In some cases, evidence of secondary considerations is highly probative on the question of obviousness. *Richardson v. Suzuki Motor Co.*,

¹ The Brief cited to paragraph 9, but it is clear from the Declaration that paragraph 10 was meant.

868 F.2d 1226, 1483 (Fed. Cir. 1989). However, the existence of such evidence does not control the obviousness determination, it remains in the realm of secondary considerations. *Id.* A nexus between the merits of the claimed invention and the evidence of secondary considerations is required in order for the evidence to be given substantial weight in an obviousness decision. *Stratoflex Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 1539 (Fed. Cir. 1983). For instance, an asserted commercial success of the product must be due to the merits of the claimed invention beyond what was readily available in the prior art. *J.T. Eaton & Co. v. Atlantic Paste & Glue Co.*, 106 F.3d 1563, 1571 (Fed. Cir. 1997); *see also In re Caveney*, 386 F.2d 917, 923 (CCPA 1967). Put another way, commercial success is relevant in the obviousness context only if there is proof that the sales were a direct result of the unique characteristics of the *claimed invention*. *In re Huang*, 100 F.3d 135, 139 (Fed. Cir. 1996).

The evidence provided in the Kassab Declaration is not adequately probative of commercial success because the necessary nexus between the sales and the invention has not been shown. In particular, we point out that elsewhere in the Declaration, Kassab points out that consumers and commercial entities did not always perform the trimming operation. It appears that commercial success may have stemmed from aspects of the product that were already known in the art, namely, the detachment aid aspect taught by Mehrle.

III. CONCLUSION

In summary, we sustain the rejection of claims 1,2, 4-6, 11, 14, and 22-24 under 35 U.S.C. § 103(a) as unpatentable over Mehrle in view of

Courtney and Nishizawa and optionally the admitted prior art, Hawkins, and Langen; we sustain the rejection of claims 1, 14, and 22 under 35 U.S.C. § 103(a) over Langen in view of Honaker or Yoshida; we sustain the rejection of claim 23 under 35 U.S.C. § 112, ¶ 2 and also under 35 U.S.C. § 103(a) over Mehrle in view of Nishizawa and further in view of at least one of Hawkins and Langen. We, however, do not sustain the rejection of claim 13 under 35 U.S.C. § 103(a) over Mehrle in view of Courtney and Nishizawa and optionally the admitted prior art, Hawkins, and Langen.

IV. DECISION

Accordingly, the decision of the Examiner is affirmed-in-part.

V. TIME PERIOD FOR RESPONSE

No time period for taking any subsequent action in connection with this appeal maybe extended under 37 C.F.R. § 1.136(a)(1)(iv).

AFFIRMED-IN-PART

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